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IN THE
Supreme Court of the United States

OCTOBER TERM, 1947.

No. 558

GENERAL MOTORS CORPORATION,
Petitioner.

vs.

ELMER G. KESLING,
Respondent.

**PETITIONER'S REPLY TO RESPONDENT'S BRIEF
IN OPPOSITION TO PETITION FOR
WRIT OF CERTIORARI.**

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Respondent's reply to the Petition for a Writ of Certiorari merely takes refuge in the opinion of the Circuit Court of Appeals for the Eighth Circuit in this case. (R. 671-694; 164 F. (2d) 824.)

**Respondent Does Not Dispute the Existence of a Conflict
Between Circuits As To An Important Question of Patent
Law.**

Respondent does not dispute that in this opinion the "Circuit Court of Appeals has rendered a decision in conflict with the decision of another Circuit Court of Appeals on the same matter;" [Rule 38.5 (b) of this Court;] *i. e.*, the question whether representations made to the Patent Office to induce the issuance of a patent may be considered in the interpretation of the patent in litigation.

**The Kesting Claims Are Clearly Functional and Flaunt
This Court's Decision in Halliburton v. Walker.**

Respondent contends that the Circuit Court of Appeals in this case has "found that the claims define precise interconnections between the handle, the actuator, the shifter element, the piston, and the valve." (Resp. Br. 3.) The Circuit Court of Appeals merely found, after setting forth the five claims in issue:

"Each of these claims states the physical combination of the various mechanical elements and **their functional interrelationship and operation.**" (R. 679.)

This is also evident from the claims. Respondent carefully avoids quoting them. All follow the same pattern. Claim 25 reads:

"25. Gear shifting mechanism of the character described comprising
 gear shifter elements,
 an actuator mounted for selectively moving said shifter elements,
 suction mechanism connected to said actuator for operating said actuator to move said shifter elements,
 a valve controlled by said actuator for regulating said suction mechanism, and
 other means for initially controlling said actuator." (R. 187; 616; 679.)

Respondent argues that this claim complies with the prescription of this Court in *Halliburton v. Walker*, 329 U. S. 1. In that opinion this Court criticized the patentee's claiming a combination "in terms of what it will do rather than in terms of its own physical characteristics or its arrangement in the new combination apparatus." (329 U. S. 9.)

That criticism manifestly reaches the Kesling claims. There the actuator is described merely as "mounted for selectively moving said shifter elements." The suction mechanism, which is necessarily "connected to said actuator," is merely described "for operating said actuator to move said shifter elements." The valve is merely described as "controlled by said actuator for regulating said suction mechanism." And the anonymous "other means" is identified merely as something "for initially controlling said actuator."

No demonstration is needed of the complete functionality of these claims.

No findings of the Court or statement in the opinion of the Court of Appeals can find anything in these claims other than this functionally described mechanical melange.

This is all quite apart from the presence in this claim as its "heart," to use the language of the Circuit Court of Appeals, of the versatile, formless and undefined "actuator." The fact that that term appears in the claims and is not defined in the specification bothers Respondent not at all. Respondent says that "everyone who has been involved in this case has identified the actuator with no trouble." That may be true, as it would be impossible to contest an asserted infringement without assuming and assigning to the terms of the claim some meaning as a necessary hypothesis for the defense.

Respondent and Petitioner can, of course, identify what the "actuator" had to be in the Kesling structure. This was made apparent in the argument Kesling made to the Patent Office. The District Court also found,

"This actuator was a composite of members arranged to cause the hand lever and the power device to operate in a **timed relationship**." (Finding of Fact, 9; R. 638.)

The difficulty does not arise in identifying what must have been the "actuator" in Kesling's structure. The difficulty arises in the fact that the term, when presented in the claim without further particularization and with Kesling's representations to the Patent Office discarded, means anything that the patentee may assert it to mean, and that the claims thus fall short of compliance with the Patent Act (R. S. 4888; Title 35; U. S. Code; Sec. 33).

The law is not satisfied because in a given structure the word may be assigned a meaning. The statute demands clarity in the claims so that the world may know the limits of the monopoly accorded by the grant of the patent.

The sweeping and indiscriminating grasp of this terminology becomes apparent when the District Court's definition of the "actuator" (quoted from R. 638, page 3 above) is compared with the same court's definition of the term in applying it to the accused Chevrolet Shifter in Findings 16 and 19 (R. 641):

Finding 16. "The composite linkage of Chevrolet includes three levers, all permanently attached together and secured to a shaft. (fol. 602.) The shaft is connected to the shifter elements. The lever group is connected to the hand lever, the valve, and the piston also. The connections are such that the hand lever is at all times connected to the shifter elements, and affords a continuous mechanical connection between the hand of the operator and the gear being shifted."

Finding 19. "An 'actuator' being something that actuates or puts into action or motion or incites to action, the composite linkage of the Chevrolet shifter is properly termed an 'actuator'." (R. 641.)

The District Court then ignored the "timed relationship" with which it defined the actuator in Finding 9.

The Circuit Court of Appeals similarly recognized these differences in structure (R. 692-693), but because of its re-

fusal to demand the structural precision required in combination claims, was able to apply them without restraint upon resemblances of function and effect. (R. 692-693.)

Respondent also entirely misses the point of the complaint as to the word "feel." While Respondent concedes that the patent does not mention this word and quotes the Circuit Court of Appeals at great length on the presence of "feel" in the respective structures involved, Respondent overlooks the fact that the Circuit Court of Appeals both said,

"The presence of the appreciation of 'feel' by Kesling is necessarily implied." (R. 682.)

and then found that because Kesling—

"uncovered this governing principle * * * he is entitled to a reasonably liberal range of protection." (R. 686.)

The Court then applied as a test of infringement, not the language of the claims, but the presence of this unidentified, functional phenomenon.

There is thus a substitution for the specific, structural terms which are necessary in a patent claim, an entirely new definition of the monopoly in terms merely of a function and effect not mentioned in the patent.

The File Wrapper Matter Is Not a Question of What the Circuit Court of Appeals Quoted From the File Wrapper But What Law Was Applied in Discarding These Vital Representations Made to the Patent Office.

Respondent dismisses the second question raised by the Petition for Writ of Certiorari on the effect of representations made to the Patent Office upon the interpretation of claims, by its statement that "The Court of Appeals quoted the language (from the file wrapper) in its opinion." (Resp. Br. p. 14.)

That is true. But immediately following this quotation from the file wrapper the Circuit Court of Appeals uttered an enlightening paragraph in which it expressly demonstrated that it was not looking to the claims or to the representations made to the Patent Office to interpret the patent, but was looking for a "conception" revealed by considering the state of the art, the implications of the patent specification to one skilled in the art, and only "limitations imposed and accepted during the progress of the application through the Patent Office."

"Summary of Scope of Patent. The scope of a patent is not a mathematical measurement. It is a *conception* reached by consideration of the combined effects of the state of the art, the contributions as revealed in the language of the patent to one skilled in the art, and any limitations imposed and accepted during the progress of the application through the Patent Office (*Smith v. Mid-Continent Inv. Co.*, 8 Cir., 106 F. (2d) 622, 624)." (R. 684.)

Thus the Court of Appeals quoted the language from the file wrapper and then immediately cited its own earlier opinion that these representations would not be considered in construing the patent claims, for in *Smith v. Mid-Continent Investment Co.*, that Court said:

"* * * We consider only the rejection and substitution of claims as the possible basis of estoppel." (106 F. (2d) 622, 627.)

It is not enough that the Circuit Court of Appeals quoted and then discarded the representations appearing in the file wrapper. The question raised by this Petition is whether or not the Circuit Court of Appeals' decision discarding these representations, in conflict with the decisions on this question in the First, Third, Sixth and Seventh Circuits, is the law.

Finally, it must be observed that in urging that the

Circuit Court of Appeals found "timed relationship" asserted for the Kesling structure in the accused Chevrolet shifter. Respondent cuts out its quotation from Record 692-694 between these revealing passages:

"The important consideration (in Chevrolet) is that the power does become effective before any pronounced movement of the gear shift elements. (R. 692.)

"Concisely, this method of operation is manual force admitting power force before any consequential movement of the gear shifting elements and, from there on throughout the entire normal gear shifting operation, *a unison of manual and power forces* with complete control in and mechanical connection with the hand of the driver—permitting 'feel'—*up to completion of the gear shift.*

* * * * *

"The difference between these two methods of operation has been aptly described by a witness for appellee. He states that the accused does the work of gear shifting 'by a division of forces'—*the hand and power acting together* to supply the united force—; while Kesling does this work by a 'division of portions of the shifter movement'—the hand doing the first part of the operation and the power doing the final part.

"It would seem that the accused device meets better the prime purpose of using power in shifting gears because it utilizes power to carry, *throughout the shift*, eighty per centum of the labor of shifting. On the other hand, Kesling uses no hand power in the final meshing while appellant uses twenty per centum of the force there employed. Even if accused may be the better structure, that is not decisive here." (R. 692-694.)

How can there be a "timed relationship" when there is "a unison of manual and power forces * * * up to completion of the gear shift," and the gear shifting is accomplished by "the hand and power acting together * * * throughout the shift"?

These passages eloquently establish that there is no timed relationship in Chevrolet. There the manual control and application of power "in unison" is continuous and indispensable. In Kesling there is manual control and manual application of force only until initial meshing of the gears and then complete lack of manual control or aid.

The Court of Appeals clearly discarded the vital representations made to the Patent Office to induce issuance of the patent, contenting itself with mere quotation of the language and re-affirming its view that such representations cannot affect the meaning of patent claims.

Conclusion.

There is no dispute that a conflict exists between the several Circuit Courts of Appeals as to an important question of patent law, whether representations made to the Patent Office to induce the issuance of a patent must be considered in the interpretation of the patent claims so procured.

In this case the Circuit Court of Appeals clearly discarded those representations as ineffective in construing the patent claims. The Court also ignored the requirements of combination claims prescribed in *Halliburton v. Walker*, 329 U. S. 1.

The effect of this decision is to permit a patentee to enforce a patent for mere functions and undisclosed functional effects, "feel", instead of confining him to structural claims of the precision which the statute dictates.

The Petition should be granted.

Respectfully submitted,

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Chicago, Illinois,
February 20, 1948.